

Appl. No. 09/844,175
Response to 11/16/2006 Office Action

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REMARKS

Applicants hereby add new claims 93-102 and cancel claims 40-42. Accordingly, claims 31-39, 54, 56-65, 67-70, 75-89 and 92-102 are pending in the present application.

Claims 31-34, 35-36, 38, 40-41, 54, 56-59, 61-65, 67-70, 75-76, 79-80, 89 and 92 stand rejected under 35 USC 102(b) for anticipation by Japanese reference Hei 3-69131 Nakano. Claims 37, 39, 42, 60, 77-78, and 81-88 stand rejected under 35 USC 103(a) for obviousness over Nakano in view of U.S. Patent No. 4,937,653 to Blonder et al.

Applicants respectfully request reconsideration of the rejections.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 5), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail in the prior art as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements of the prior art must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to claim 31, the apparatus comprises an *engagement probe having an outer surface comprising an apex in the form of a knife-edge line*. At page 2 of the Office Action, the Office identifies reference 22 as teaching the claimed engagement probe. However, the Office has failed to identify any teachings that reference 22 discloses the claimed outer surface comprising an apex in the form of a knife-edge line. The interpretation of the teachings of Nakano to disclose a knife-edge line is entirely contrary to the explicit teachings of the prior art. In particular, reference 22 of Nakano is disclosed as being needle-shaped per the third full paragraph of page 3 of the translation of Nakano or a cone shape as shown in Fig. 2a and described at the second full paragraph of page 5 of

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the translation of Nakano. In no fair interpretation, may the needle-shaped or cone-shaped protuberances of Nakano be considered to teach or suggest the specifically-claimed knife-edge line of claim 31.

In no fair interpretation, may the needle or cone shaped protuberances of Nakano be considered to teach or suggest the claimed apex in the form of a knife-edge line as used in the present application. Applicants refer to Fig. 6 of the present application which depicts one embodiment of apexes 40, 42, 44, 46, 48, 50, 52 and 54 which are individually in the form of a knife-edge line and which may not be fairly considered to be taught by the needle or cone shaped structures of Nakano.

Applicants also refer to the Office Action response of December 12, 2003 and the dictionary definition of "knife-edge" submitted therewith and which defines knife-edge as "a sharp narrow edge or margin like that of a knife" or "a narrow ridge." The needle-shaped or cone-shaped protuberances of Nakano *individually having a point* may not be fairly considered to teach a sharp narrow edge or margin like that of a knife or a narrow ridge. Furthermore, the Office has identified no teachings in the prior art that the needle-shaped or cone-shaped protuberances of Nakano may be fairly considered to disclose or suggest the claimed apex in the form of a knife-edge line as used in Applicant's specification and as understood in the art.

Applicants respectfully submit that the claimed apex in the form of a knife-edge line is not taught by the prior art and the 102 rejection of claim 31 is improper for at least this reason.

Applicants have identified herein claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made,

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Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final* Action if claim 31 is not found to be allowable.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 103 rejection of claims 81-88, Applicants respectfully assert that the Office has failed to establish a proper *prima facie* 103 rejection and the claims are allowable for this additional reason.

In particular, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 5).

MPEP 2142 (8th ed., rev. 5) states that the concept of *prima facie* obviousness

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allocates who has the burden of going forward with production of evidence in each step of the examination process and the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.

For a proper 103 rejection, the examiner must establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Reasons for the decision to combine references must be articulated. *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The examiner must show that there is a rationale to combine references relied on as evidence of obviousness. *Id.* 277 F.3d at 1343, 61 USPQ2d at 1433-34. It is insufficient to rely on the examiner's own understanding or experience, or the Examiner's assessment of what would be basic knowledge or common sense but rather must point to some concrete evidence in the record in support of these findings. *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The Examiner must make requisite findings, based on evidence of record, and also explain the reasoning by which the findings are deemed to support the examiner's conclusion.

In the present action, the Office has failed to present or establish a factual basis for combining the teachings of Blonder with the teachings of Nakano in support of the 103 rejection of claims 81-88 and the rejection is improper for at least this reason. Applicants respectfully assert the Office has failed to meet its burden of establishing a proper prima facie 103 rejection and the claims are allowable.

Furthermore, Applicants respectfully assert that the rejection relying upon "obvious design choice" is improper. In particular, Applicants refer to *In re Chu*, 36 USPQ2d 1089 (CAFC 1995) wherein the CAFC reversed a 103 rejection (which was previously affirmed by the Board) which relied upon a rationale that claimed limitations where merely a matter

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of design choice. In overturning the 103 rejection, the CAFC stated that there was no teaching or suggestion in the prior art in support of the rejection. As mentioned above, there is no factual basis for combining or modifying the teachings of Nakano. In consideration of the lack of any objective evidence to support the combination, the Office has improperly relied upon Applicant's disclosure in formulating the 103 rejection. Mores specifically, a combination must be based on something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination.

See, e.g., *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants have reviewed *In re Dailey*, 49 USPQ 47 (CCPA 1966) (which is relied upon by the Office) and failed to find any support therein for the position that the positively claimed limitations are obvious design choices or that the burden is on Applicants to establish criticality of the claimed limitations. To the contrary of the position of the Office, Applicants submit the rejection is improper for lack of factual basis for the combination or modification of Nakano per the CAFC holding of *In re Chu*.

Referring to the rejection of claim 54, the Office fails to identify teachings in the prior art of the positively claimed *apex in the form of a knife-edge line*. The needle-shaped or cone-shaped protuberances of Nakano failed to teach or suggest the claimed knife-edge line limitations and claim 54 is allowable for at least this reason.

The claims which depend from independent claim 54 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 103 rejection of claim 77, the cone-shaped and needle-shaped protuberances of Nakano fail to teach or suggest the claimed limitations of the *engagement probe comprising an apex in the form of a knife-edge line*. The Office fails to recite any

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teachings in the prior art of the above-recited claimed limitations and has failed to meet their burden of establishing a proper prima facie 103 rejection. Finally, there is no proper factual basis for modifying the cone-shaped and needle-shaped teachings of Nakano to arrive at the limitations of claim 77 and the 103 rejection is improper for this additional reason. Applicants respectfully request allowance of the claims for at least the above-mentioned reasons.

The claims which depend from independent claim 77 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 79, the Office fails to identify teachings in the prior art of the positively claimed *apex in the form of a knife-edge line*. The needle-shaped or cone-shaped protuberances of Nakano failed to teach or suggest the claimed knife-edge line limitations and claim 79 is allowable for at least this reason.

The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 89, the Office fails to identify teachings in the prior art of the positively claimed at least one *apex in the form of a knife-edge line*. The needle-shaped or cone-shaped protuberances of Nakano failed to teach or suggest the claimed knife-edge line limitations and claim 89 is allowable for at least this reason.

Applicants have amended the independent claims for clarity. The amendments made herein to the independent claims either broaden the claims or now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

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Applicants submit new claims 93-102 herewith and which are supported at least by Figs. 4, 11 and 14 and the respective teachings of the specification.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 3/16/07

By: 
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